APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
COOK.I

ART UNIT	PAPER NUMBER
1641	7

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DATE MAILED:
06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on _Feb 4, 1999_

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____1___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

    ☒ Claim(s) _1-50_____ is/are pending in the applicat

    Of the above, claim(s) _____ is/are withdrawn from consideration

    ☐ Claim(s) _____ is/are allowed.

    ☐ Claim(s) _____ is/are rejected.

    ☐ Claim(s) _____ is/are objected to.

    ☒ Claims _1-50_____ are subject to restriction or election requirement.

Application Papers

    ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

    ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

    ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

    ☐ The specification is objected to by the Examiner.

    ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

    ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

        ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

            ☐ received.

            ☐ received in Application No. (Series Code/Serial Number) _____ .

            ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

        *Certified copies not received: _____

    ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

    ☐ Notice of References Cited, PTO-892

    ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

    ☐ Interview Summary, PTO-413

    ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

    ☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   Claims 1-17 and 25, are drawn to a method of identifying antibodies via antigen binding, classified in class 435, subclass 7.21.

    II.   Claims 18-24, 26, and 48-50, are drawn to a method of comparing protein expression in cell populations, classified in class 435, subclass 70.1.

    III.   Claims 28-30, are drawn to a method of diagnosing a disorder, classified in class 424, subclass 9.1.

    IV.   Claims 31-40, are drawn to kits comprising antibodies immobilized on a solid surface, classified in class 530, subclass 300 and classified in class 530, subclass 387.1.

    V.   Claims 41-47, are drawn to a method of comparing protein expression via nucleic acid probes, classified in class 435, subclass 91.1.

2.   The inventions are distinct, each from the other because of the following reasons:

    Inventions I, II, III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed to be utilized

together, have different modes of operation, and have different functions. The methods

have different method steps and employ different reagents (i.e. See specification

examples 1 and 2). Specifically, the method of Group I identifies antibodies having

binding affinity for an antigen, the method of Group II compares protein expression in

two or more populations of cells via antibody binding patterns, the method of Group III

detects a disorder (stroke, cerebral hemorrage, myocardial infarction, peripheral blood

clots, diabetes, cancer, Alzheimer's, or sepsis), an the method of Group IV compared

prtoein expression patterns via nucleic acid probes. For these reasons set forth above

the methods are patentably distinct.

Inventions V and (I, II, III, and IV) are related as product and process of use. The

inventions can be shown to be distinct if either or both of the following can be shown: (1)

the process for using the product as claimed can be practiced with another materially

different product or (2) the product as claimed can be used in a materially different

process of using that product (MPEP § 806.05(h)). In the instant case the product of

Group V can be utilized in any of the four materially different processes. The kits recited

product of Group V can be employed in the methods of Group I, II, III or Group IV.

Further, the kits are not a required limitation for the practice of the aforementioned

methods. The methods are not limited to a kit configuration, such assays can be

designed to effectively work in microtiter plates, test tubes, or chromatography

applications, wherein the reagents are manually made and utilized. Since, the

kit/product can be employed in these diverse methods, restrict is proper.

3.   Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Please note that the classifications in the restriction are illustrative only and **do not** represent all the classes and subclasses which must be searched for each invention; nor is the search limited to issued US patents, but rather includes foreign patents and applications as well as literature searches.

4.   Applicant is advised that the reply to this requirement be complete and must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5.   Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6.   Papers related to this application may be submitted to Group 1600 by facsimile

transmission. Papers should be faxed to Group 1600 via the PTO fax Center located in

Crystal Mall 1. The faxing of such papers must conform to the notice published in the

Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is

(703) 308-4242, which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-

0808. The examiner can normally be reached on Monday – Friday from 8:00AM –

4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 308-

0196.

Lisa V. Cook
Art Unit 1641
CM1-7D16
(703) 305-0808
June 16, 2000

CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800/641